



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,166	07/10/2003	Randall Eric Swanson	2295-004	4355
20575	7590	04/10/2006		
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			EXAMINER ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C-1

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,166	<b>Applicant(s)</b> SWANSON, RANDALL ERIC	
	<b>Examiner</b> Daniel Zirker	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The Examiner notes for the record that applicant's Response is not properly characterized as an "Amendment after Final Rejection under 37 CFR 1.116", as it's page 1 Heading states.
3. Claims 1-5, and 18-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Examiner initially points out the minor informality in claim 1, last line, that "a" should be --the--. In claim 3, "or other plastic film" is vague and indefinite. In claims 1 and 18, "pre-applied" is vague, indefinite and confusing with respect to the claimed article. In claim 21 it appears as the claim now reads that the outer adhesive layer is adhered on its outward surface to the center reinforcement, which the Examiner believes is not a contemplated embodiment. Finally, in newly presented claim 30 the phrase, "single, contiguous" material is not understood; although applicant's Response appears to argue (page 7, 2<sup>nd</sup> paragraph) that "contiguous sheet" means that it is non perforated, the Examiner finds this statement to be confusing in that such embodiments are not believed to be structures conveyed by the normal meaning of these words.
4. Claims 4, 18-23 and 25-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

Art Unit: 1771

was filed, had possession of the claimed invention. More particularly, the newly presented claims appear to contain several amendments which appear to be new matter. In claim 4 "single...material" and in claim 18, "non-perforated", although in significantly different form from one another each appears to qualify as new matter under the rule of **Ex Parte Grasselli et al.- Bd. Of Appeals 231 USPQ 393, Affd. 738 F.2d 453 (Fed Cir 1984)** to the effect that limitations such as "free of" a particular element are new matter in the absence of express support. Note that nowhere does applicant point out where such support exists, and also note that it is believed that applicant's drawings do not provide such support (applicant's specification is silent on the "non-perforated" issue) and mere partial drawings of the element, coupled without any express supporting disclosure, are clearly deemed inadequate. As regards the claim 4 "single tear-resistant material", since this is also believed to require only one type of tear resistant material present, i.e. a plastic film formed from a homogeneous composition which is tear resistant, it is suggested to delete "single". In claim 21 the fact that the center reinforcement is also "adhered to the adhesive layer" is believed to be new matter, as no support has been pointed out or is believed to exist. As regards claims 26-29 it is suggested to delete "single" in claim 26 for the same or very similar reasons that it is suggested to delete the word in claim 4. Finally, in claim 30 "single, contiguous material" finds no express or, it is believed, inherent support in the specification and since applicant has stated that it means a "non-perforated" sheet it is also new matter under the **Grasselli et al** rule.

Art Unit: 1771

5. Claims 1-5, and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for claims 1-5, 20, 31 and 32, for claim 5 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada, substantially for reasons already of record, together with the following additional observations. More particularly, Owens et al is again relied upon as previously set forth, with the limitation (claims 1, 18) "a substantially uniform thickness" believed to be a routine design parameter, as is the presence of a "pre-textured" ready to paint layer. With respect to the limitations of a "non-perforated" sheet (claim 18), and the urged equivalent in claim 30, "single, contiguous material", note Col 3, lines 14-15 of the reference, which discloses that plastic sheets not having holes may be used. Owens et al is also further relied upon as disclosing "center reinforcements" and related structures (note Col 1, line 66-Col 2, line 12) as are set forth in dependent claims 21-23. Alternatively, each of the secondary state of the art references is again relied upon as previously set forth, and the Examiner again notes that applicant has not attackied the Examiner's interpretation of the disclosure of each of these references.

6. Claims 1-5 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Sr. '949, taken either individually, or alternatively as evidence of the state of the art in view of Swallow for all of the rejected claims, and for claim 5 in view of the FASSON publication, substantially for reasons already of record, together with the following additional observations. More particularly, the Examiner further notes that these claims permit the presence of a perforated sheet of film as an essential element

Art Unit: 1771

of the patch, and with respect to dependent claims 26-29 the utilization of a "single puncture resistant material" such as various plastics including polypropylene is believed to at least be within the skill of the art in view of the reference's teachings at e.g. Col 2, lines 55-58 and Col 4, lines 45-54. The Examiner has little else to add besides again noting that dependent claims 24 and 25 which additionally texture the patch with a mixture of paint and mud is a structure that is again relied upon as being well within the ordinary skill of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 -1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/618,166

Page 6

Art Unit: 1771

Daniel Zirker  
Primary Examiner  
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'Z'.